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PATENT  
Attorney Docket No. 05725.0785  
Customer No. 22,852

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Sandrine DECOSTER et al.

Application No.: 09/692,716

Filed: October 20, 2000

For: COSMETIC COMPOSITIONS COMPRISING AT  
LEAST ONE SILICONE COPOLYMER IN  
AQUEOUS EMULSION AND AT LEAST ONE  
THICKENER, AND USES THEREOF

Group Art Unit: 1617

Examiner: G. Yu

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

**REPLY BRIEF UNDER 37 C.F.R. § 1.193**

Pursuant to 37 .C.F.R. § 1.193, Appellants present in triplicate its Reply to the Examiner's Answer dated August 26, 2003. If any fees are required in connection with the filing of this paper, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

**REMARKS**

**I. Grouping of Claims**

Appellants note that the Examiner believes that the "claims stand or fall together." Examiner's Answer p. 2. Appellants disagree, and submit the Examiner is

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simply dismissing limitations recited in the dependent claims that further distinguish the claimed invention from the prior art.

In accordance with 37 C.F.R. §§ 1.192(c)(7) and (8), Appellants stated that the claims do not stand or fall together, divided the claims into groups, and set forth arguments for each grouping of claims explaining why it is believed these claims are separately patentable over the prior art relied upon by the Examiner. By stating that the "claims stand or fall together," the Examiner has chosen to gloss over the limitations recited throughout the claims, as well as Appellants' arguments for separate patentability over the prior art. Because not all rejections apply to all claims, Appellants submit that the Examiner's position is improper, and request that the claims be groups as set for in the Appeal Brief.

## II. Status of Rejections

In response to the Appeal Brief filed June 4, 2003, the Examiner has maintained the following rejections:

A. Claims 1-18, 21, and 101-104 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0874017 A2 ("DALLE") in view of Zviak, C., *The Science of Hair Care*, Marcel Dekker, Inc. (1986) pp. 68-70 ("ZVIAK").

B. Claims 1-17, 19, 20, 22, 24, and 101-104 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DALLE (EP 0874017) in view of QUACK (U.S. Patent No. 4,237,243).

C. Claims 1-19, 22, 23, 25-36, and 101-104 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DALLE (EP 0874017) in view of MOUGIN (U.S. Patent No. 6,166,093).

D. Claims 37-63 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DALLE (EP 0874017) in view of MOUGIN (U.S. Patent No. 6,166,093) in further view of RESTLE (U.S. Patent No. 6,039,936).

E. Claims 64-100 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DALLE (EP 0874017) in view of MOUGIN (U.S. Patent No. 6,166,093) in further view of DECOSTER (U.S. Patent No. 6,150,311).

### III. Response to Arguments in the Examiner's Answer

Appellants maintain that a prima facie case of obviousness has not been established for the reasons set forth in the Appeal Brief filed June 4, 2003, as well as those below.

The Federal Circuit has held that there must be a clear and particular suggestion in the prior art to combine the teachings of the cited references in the manner proposed by the Examiner. As explained by the Federal Circuit, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re*

*Dembiczak* 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

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The Examiner can meet the burden of establishing a prima facie case of obviousness "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (internal citations omitted) (emphasis added). The Federal Circuit reaffirmed the Examiner's high burden to establish a prima facie case of obviousness in *In re Sang-Su Lee*, where the Federal Circuit explained that

[t]he need for specificity pervades this authority... the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

277 F.3d 1338, 1433 (Fed. Cir. 2002) (internal citations and quotation omitted) (emphasis added).

**A. DALLE in view of ZVIAK does not provide the requisite motivation to combine.**

Appellants submit the Examiner has failed to establish a prima facie case of obviousness at least because she has failed to point to any clear and particular motivation to combine the teachings of DALLE with those of ZVIAK.

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First, the Examiner argues that Appellants have "not shown unexpected benefits by clear and convincing evidence that is commensurate with the scope of the claims." (Examiner's Answer p. 9). However, the burden does not shift to Appellant to demonstrate unexpected results until after a prima facie case has been established by the Examiner. Here, the Examiner has not met the initial burden. Thus, any discussion by the Examiner regarding "unexpected benefits" is misplaced.

Second, while both silicone copolymers and non-cellulose thickeners can be found in hair care products, it cannot be true that it would have been obvious to one skilled in the art to combine every substance in every hair care product in every conceivable combination. Such innumerable combinations might be "obvious to try," but "'obvious to try' is not the standard." *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1374, 56 U.S.P.Q.2d 1065, 1075 (Fed. Cir. 2000). Nevertheless, it appears to be the Examiner's erroneous belief that any combination of substances found in hair care products is obvious simply because each individual substance is found that art.

In an attempt to support this position, the Examiner misapplies the holding in *In re Kerkhoven*, 626 F.2d 848, 205 U.S.P.Q. 1069 (C.C.P.A. 1980). In that case, claims to a process of preparing a spray-dried detergent by mixing together two conventional spray-dry detergents were held to be prima facie obvious.

However, the instant case is readily distinguishable from *In re Kerkhoven* on its

facts. In *In re Kerhoven*, the scope of the art at issue was the comparably small field of spray-dried detergents. In contrast, the art in the instant case is the vast field of hair care products. Moreover, the two detergent compositions were mixed together in their entirety; here, the Examiner is selecting individual components from different hair care products and combining them.

Notwithstanding these substantial differences, the Examiner incorrectly argues that the holding in *In re Kerkhoven* applies to this case. Such an extrapolation of the holding in *In re Kerhoven* would amount to nothing less than the application of the impermissible "obvious to try" standard as discussed above.

Third, the Examiner states that the Federal Circuit holding in *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002), is inapplicable in this case. (Examiner's Answer p. 10). Curiously, the Examiner cites a section of *In re Lee* that actually undermines her argument. The Examiner correctly recognizes that *In re Lee* holds that the factual question of motivation may not be resolved on subjective belief and unknown authority. (Examiner's Answer p. 10, *In re Lee* at 1343-44.)

The Examiner then states that because the motivation to combine "flows" from the teachings of DALLE and ZVIAK, such a combination would have been obvious. But such conclusory statements are exactly what the Federal Circuit found inadequate in *In re Lee*. (See *In re Lee* at 1443 ("The examiner's conclusory statements...do not adequately address the issue of motivation to

combine.”) Neither DALLE nor ZVIK provide any specific motivation to combine the silicone copolymers of DALLE with the non-cellulose thickeners of ZVIK.

Forth, contrary to Appellants' assertions, the Examiner maintains that hindsight reconstruction is permissible in this case. For support, the Examiner cites *In re McLaughlin* for the proposition that some reconstruction is proper so long as it takes into account only knowledge within the level of ordinary skill at the time the invention was made, and does not include knowledge gleaned only from applicants' disclosure. (Examiner's Answer p. 11). Despite citing the case, the Examiner *has* gleaned knowledge from Applicants' disclosure because there exists no specific motivation combine the teaching of DALLE with ZVIK in the references or in the ordinary skill in the art. Therefore, the Examiner's rejection is improper and should be reversed.

**B. DALLE in view of QUACK does not provide the requisite motivation to combine.**

Appellants submit that the Examiner has failed to establish a prima facie case of obviousness at least because the Examiner has failed to find any clear and particular motivation to combine the teachings of DALLE with those of QUACK.

For the reasons stated previously, *In re Kerhoven* is not applicable to this case. The Examiner is incorrect that the motivation for combining DALLE and QUACK “flows logically” from that fact that they both are applicable to the

cosmetic arts. Furthermore, the teachings of DALLE do not suggest the need or possibility of altering viscosity, or any other specific motivation to combine DALLE with QUACK.

Therefore, no motivation to combine DALLE and QUACK exists in the references, and this rejection is improper.

**C. DALLE in view of MOUGIN does not provide the requisite motivation to combine.**

Appellants submit that the Examiner has failed to establish a prima facie case of obviousness at least because the Examiner has failed to find any clear and particular motivation to combine the teachings of DALLE with those of MOUGIN.

For the reasons stated previously, *In re Kerhoven* is not applicable to this case. The Examiner is incorrect that the motivation for combining DALLE and MOUGIN "flows logically" from that fact that they both are applicable to the cosmetic arts. While MOUGIN discloses the use of thickening agents for use in various cosmetic products, this teaching is far too general to provide the requisite specific motivation to combine the teachings of DALLE with the teachings of MOUGIN; the Examiner cannot pick and choose among isolated disclosures in the references to deprecate the claimed invention because this amounts to improper hindsight reconstruction. See, *In re Fine*, 837 F.2d 1071, 1075, 5



U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Therefore, no motivation to combine DALLE and MOUGIN exists in the references, and this rejection is improper.

**D. DALLE in view of MOUGIN in further view of RESTLE does not provide the requisite motivation to combine.**

Appellants submit that the Examiner has failed to establish a prima facie case of obviousness at least because the Examiner has failed to find any clear and particular motivation to combine the teachings of DALLE with those of MOUGIN and RESTLE.

Contrary to the Applicants' assertions, the Examiner has argued that DALLE does not teach away from use of the cationic surfactants of RESTLE because "the disclosure of the potential irritability of the surfactants and instability effects thereof refer to the drawback of the emulsion polymerization, and not to the alleged disadvantages of using the Restle cationic surfactants with the Dalle silicone copolymers." Applicants disagree. DALLE teaches away from using cationic surfactants with emulsions like those in the instant claims. As the reference states, "cationic surfactants used in these emulsions can be irritating to the skin and they can affect the stability of products into which the emulsions are incorporated." (DALLE p. 2, lines 19-20). The fact that the invention of RESTLE sought to alleviate this drawback does not detract from cited teaching in DALLE. Therefore, no motivation to combine DALLE and MOUGIN with RESTLE exists in the references, and this rejection is improper.

**E. DALLE in view of MOUGIN in further view of DECOSTER does not provide the requisite motivation to combine.**

Appellants submit that the Examiner has failed to establish a prima facie case of obviousness at least because the Examiner has failed to find any clear and particular motivation to combine the teachings of DALLE and MOUGIN with those of DECOSTER.

For the reasons stated previously, *In re Kerhoven* is not applicable to this case. The Examiner is incorrect that the motivation for combining DALLE and MOUGIN with DECOSTER "flows logically" from that fact that they both are applicable to the personal cleansing compositions. This teaching is far too general to provide the requisite specific motivation to combine the teachings of DALLE and MOUGIN with those of DECOSTER; the Examiner cannot pick and choose among isolated disclosures in the references to deprecate the claimed invention because this amounts to improper hindsight reconstruction. See, *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Therefore, no motivation to combine DALLE and MOUGIN with DECOSTER exists in the references, and this rejection is improper.

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**IV. Conclusion**

For the foregoing reasons, and the reasons of record, the Examiner's rejections of the claims is improper and should be withdrawn. Appellants respectfully request that the rejections be reversed and withdrawn.

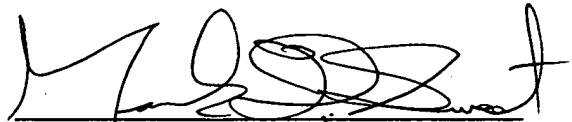
Please grant any extensions of time required to enter this brief and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: October 27, 2003

By:



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